

REMARKS/ARGUMENTS

In response to the Office Action dated April 6, 2005, claims 1, 5, 11 and 12 are amended. Claims 1-12 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

I. Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dent et al. (USPN 6,128,603).

Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Morgan et al. (USPN 5,799,286).

II. The rejections are respectfully traversed.

(a) A first issue is the fact that claims 12-14 were renumbered to be claims 10-12 in the Preliminary Amendment filed June 1, 2001 as no claims 10 and 11 were presented on page 101 of the original specification. Consequently, the Examiner's comments with respect to claims 12-14 are considered to be applicable to previously presented claims 10-12, respectively, as previously presented claim 10 corresponds to original claim 12, previously presented claim 11 corresponds to original claim 13, and previously presented claim 12 corresponds to original claim 14.

(b) As another issue, it is noted that the PTOL-326 indicates that claims 5-14 are objected to under item 7, and on page 4 of the Office Action, at item 6, the Examiner indicates that claims 5 and 14 (current claim 12) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Since there is no specific reference to claims 5 and 14

(currently claim 12) under items 4 and 5 of the Office Action, it is believed that claims 5 and 14 (currently claim 12) are not rejected under 35 U.S.C. § 102(e) as being anticipated by either Dent et al. (USPN 6,128,603) or Morgan et al. (USPN 5,799,286) .

To expedite prosecution, claim 5 is amended to be in independent form including all the limitations of base claim 1 and intervening claims 3 and 4. In addition, claim 12, (original claim 14) is amended to be in independent form including all the limitations of base claim 11 (original claim 13). Consequently, amended claims 5 and 12 are believed to be allowable.

(c) The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

There is a significant difference between the claimed invention and the arrangements disclosed by each of Dent et al. and Morgan et al. that scotches the factual determination that identically describes the claimed inventions within.

Independent claims 1 requires identifying *all sources of funds* and uses of funds for each department of a participant and independent claim 13 (original claim 11) requires that the data gathered include a list of all sources of funds and uses of funds for each department of a participant. Neither Dent et al. nor Morgan et al. provide any disclosure regarding *all sources of funds* for each department of a participant. More specifically, Dent is directed to a consumer-based bill management and payment system that is configured to receive, analyze, manage and pay electronic billing statements received from a biller over the Internet. In this regard, there is

no reasonable expectation of such a consumer to have a source of funds. While the cashflow analyzer may compute an optimized payment schedule that maximizes the amount of interest earned, such maximizing of the amount of interest earned is not considered in the arrangement of Dent to be a source of funds with regard to using funds.

Morgan et al. is directed to an automated activity-based management system and method which is concerned only with costs associated with its employers, facilities, equipment, and overhead to produce products or services.

Furthermore, neither Dent nor Morgan et al. disclose or suggest an academic health center including a school of medicine, a hospital and a clinical practice plan, as required in claim 1, or an academic health center as required in claim 11 (original claim 13).

The above argued differences between the claimed device and method vis-à-vis the device and method of each of Dent et al. and Morgan et al. undermine the factual determination that each of Dent et al. and Morgan et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1-4 and 6-11 under 35 U.S.C. § 102 for lack of novelty as evidenced by each of Dent et al. and Morgan et al. is not factually or legally viable.

At any rate, to expedite prosecution, claims 1 and 11 (original claim 13) are amended to more clearly delineate the subject matter of the invention. Thus, amended independent claim 1 now recites:

An automated method of tracking the flow of funds in an academic health center including a school of medicine, a hospital and a clinical practice plan as participants, including the steps of:
gathering data from each of the participants and other entities; and

loading the data into processor, the processor carrying out the functions of:
identifying, using the loaded data, all transactions across the participants and other entities;
identifying, using the loaded data, all sources of funds provided for each department of a participant;
identifying, using the loaded data, all uses of funds for each department of the participant;
analyzing the funds flow among the participants; and generating a source of funds statement and uses of funds statement for each participant using the identified sources of funds and uses of funds, wherein
the source of funds includes cash received and values received that are not cash, and
the uses of funds include cash paid and values provided that are not cash values.

Amended claim 11, (original claim 13) now recites:

A system for tracking the flow of funds in an academic health center, comprising:
a school of medicine, a hospital and a clinical practice plan as participants;
a network connecting each of the participants;
a processor for gathering data from each of the participants via the network and carrying out the functions of:
identifying, using the gathered data, all transactions across said each of the participants;
identifying, using the gathered data, all sources of funds provided for each department of a participant;
identifying, using the gathered data, all uses of funds for each department of the participant;
analyzing the funds flow among the participants; and generating a source of funds statement and uses of funds statement for each participant using the identified sources of funds and uses of funds, wherein
the source of funds includes cash received and values received that are not cash, and
the uses of funds include cash paid and values provided that are not cash values.

The subject matter now recited in amended independent claims 1 and 11 (original claim 13) is not disclosed or suggested in Dent or Morgan et al. Consequently, the allowance of amended independent claims 1 and 11 (original claim 13), as well as of dependent claims 2-4 and 6-10, is respectfully solicited.

REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 101

Claim 1 is rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. The claim advises to add a computer or process into claim 1 in order to overcome this rejection.

To expedite prosecution, claim 1 is amended, as noted above, to recite:

An *automated method* of tracking the flow of funds in an academic health center including a school of medicine, a hospital and a clinical practice plan as participants, including the steps of:

gathering data from each of the participants and other entities; and

loading the data into processor, the processor carrying out the functions of:

identifying, using the loaded data, all transactions across the participants and other entities;

identifying, using the loaded data, all sources of funds provided for each department of a participant;

identifying, using the loaded data, all uses of funds for each department of the participant;

analyzing the funds flow among the participants; and generating a source of funds statement and uses of funds statement for each participant using the identified sources of funds and uses of funds, wherein

the source of funds includes cash received and values received that are not cash, and

the uses of funds include cash paid and values provided that are not cash values. (Emphasis added)

As amended independent claim 1 now includes a processor, it is respectfully solicited that the rejection under 35 U.S.C. § 101 be withdrawn.

CONCLUSION

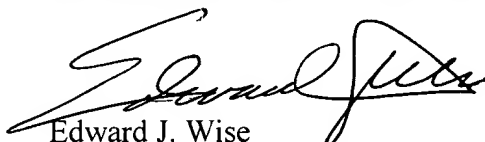
Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No.: 09/857,275

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over the printed name.

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